

Remarks/Arguments

The Rejection of Claims 2-11, 14-16, 19-22, 24-33, 36-38, and 41-44 Under 35 U.S.C. §103

The Examiner rejected Claims 2-11, 14-16, 19-22, 24-33, 36-38, and 41-44 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,339,767 (Rivette et al.) in view of U.S. Patent No. 6,154,725 (Donner) in view of U.S. Patent No. 6,947,909 (Hoke Jr.) and further in view of U.S. Patent No. 6,401,206 (Khan et al.).

Claim 11

Meaning of "Product Document"

During a telephonic conference between the undersigned, the Examiner, and Primary Examiner James A. Reagan on September 12, 2006, the Examiner asserted that the meaning of "product document" could be broadly construed and asked the undersigned how the present invention, specifically Claim 11, was different than the USPTO databases that list patent applications or patents. The undersigned pointed out that one difference is that Claim 11 recites publishing to make a document a bar to patentability. For example, documents publicly available from USPTO databases do not become bars to patentability as of the date of publication in the databases or due to public access to these in the databases – the workings of the filing and examination process establish bar dates. For example,, the bar is established by the filing of the application or possibly the date of invention of the claimed invention. Further, the USPTO does not accept documents from other person's computers to publish these documents to establish patentability. For example, assuming that the USPTO accepted an electronically filed patent application, the application would not be published for 18 months (if at all) and the bar to patentability would be set by the filing date or date of invention, not the publication date.

Rivette does not teach the product document, the database, or the Web site recited in Claim 11

Claim 11 recites: "providing a searchable document database and a publication Web site in communication with said document database, where said database is publicly accessible;" The Examiner asserted that Figure 3 of Rivette teaches the above limitation. Applicants provided arguments regarding Rivette not teaching the database and Web site in the Request for

Reconsideration dated June 9, 2006. In the interest of brevity, these arguments are reasserted, but not repeated.

During the September 12 telephonic conference, the relevance of Rivette to the above claim limitation was discussed. The Examiner asserted that Rivette teaches publicly accessible database, in particular, since Rivette shows an HTTP network in Figure 3, the network must be publicly accessible. However, the undersigned pointed out that the HTTP protocol is used in both public and non-public (i.e., controlled access) networks. That is, the use of HTTP protocol in a network does not mean that the network is necessarily publicly accessible.

Donner does not teach receiving a product document

The arguments regarding Donner and a product document were presented in the Request for Reconsideration dated June 9, 2006, and in the interest of brevity are reasserted, but not repeated.

Hoke does not publish a document to bar patentability

Claim 11 recites: "publishing said product document by adding said product document to said document database, wherein said publishing is for the purpose of disclosing information about a product to establish a bar to patentability of inventions practiced in said product;" The Examiner has cited Col. 7, lines 14-42 of Hoke as teaching the above limitation. Claim 11 and the present invention publish a document to bar patentability by putting the document in the public realm. In contrast, Hoke teaches a means of controlling or preventing the publication or distribution of properties that are already patented or copy write protected, that is, properties that are already in the public domain. That is, nothing Hoke publishes can create a bar to patentability, since any such bar has already been established by the filing of the patented material that Hoke is controlling.

Khan does not disclose a product document

The arguments regarding Khan and a product document were presented in the Request for Reconsideration dated June 9, 2006, and in the interest of brevity are reasserted, but not repeated.

Khan does not digitally notarize a product document with a timestamp and a digital fingerprint

As noted above, Khan does not teach, suggest, or motivate a product document. Therefore, Khan cannot teach notarizing a product document.

Donner does not teach a publicly accessible database

Claim 11 recites: "providing a searchable document database and a publication Web site in communication with said document database, where said database is publicly accessible;" The Examiner has cited Fig. 2 and col. 5, lines 44-57 with respect to the above claim limitation. The cited lines teach that Donner's system can access other publicly accessible databases such as Lexis Nexis. Donner is not teaching that his database is accessible. The accessibility of a network cannot be determined from the fact that the network can itself access a publicly accessible database. For example, a publicly inaccessible system can access a publicly accessible database while remaining publicly inaccessible itself.

Khan and Rivette teach against the invention recited in Claim 11

Arguments regarding Khan and Rivette teaching against the present invention were presented in the Request for Reconsideration dated June 9, 2006, and in the interest of brevity are reasserted, but not repeated.

Donner teaches against publication

Donner is teaching a system to estimate the value of an intellectual property portfolio. The value of an intellectual property portfolio is likely to be considered sensitive information by the entity holding the portfolio. Therefore, the results of Donner's system would likely be held in confidence, not published. "A *prima facie* case of obviousness can be rebutted if one of the cited references teaches away from the claimed invention. See *In re Geisler*, 43 U.S.P.Q. 2d 1362, 1366 (Fed. Cir. 1997)."

The references cited by the Examiner, considered individually and collectively, do not contain sufficient teaching, suggestion or motivation to combine/modify the references to create the present invention.

Arguments regarding teaching, suggestion, and motivation were presented in the Request for Reconsideration dated June 9, 2006, and in the interest of brevity are reasserted, but not repeated.

Rivette, Donner, Hoke, and Kahn fail to establish a *prima facie* case of obviousness with respect to Claim 11. Therefore, Claim 11 is patentable over the cited references. Claims 2-10, 14-16, and 19-22, dependent from Claim 11, enjoy the same distinction from the cited references.

Claim 33

Claim 33 is an apparatus claim paralleling method Claim 11. Applicants have shown that Claim 11 is patentable over the cited references. Therefore, Claim 33 also is patentable over the cited references. Claims 24-32, 36-38, and 41-44, dependent from Claim 33, enjoy the same distinction with respect to the cited references.

Applicants courteously request that the rejection be removed.

United States Patent No. 6,556,992 (Barney et al.)

The Examiner cited Barney in the Response to Arguments, but did not mention Barney in the rejections. Barney teaches a method and system for rating patents. A bar to patentability with respect to any patent evaluated by Barney would be established long before Barney performed such analysis (see arguments above). Therefore, the rating performed by Barney cannot establish a bar to patentability for a patent and Barney does not teach, suggest, or motivate the invention recited in Claim 11.

The Objection of Claims 13, 17, 18, 35, 39, and 40 as Being Dependent Upon a Rejected Base Claim

Claims 13, 17, 18, 35, 39, and 40 were objected to as being dependent upon a rejected base claim, but the Examiner indicated that these claims would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claim 11 is allowable. Therefore, Claims 13, 17, and 18, dependent from Claim 11, no longer depend upon a rejected base claim. Claim 33 is allowable. Therefore, Claims 35, 39, and 40, dependent from Claim 33, no longer depend upon a rejected base claim.

Applicant request that the objection be withdrawn.

Attorney Docket No. IPCP:107US
U.S. Patent Application No. 09/931,492
Reply to Office Action of August 25, 2006
Date: September 26, 2006

Conclusion

Applicants respectfully submit that all pending claims are now in condition for allowance, which action is courteously requested.

Respectfully submitted,



C. Paul Maliszewski
Registration No. 51,990
CUSTOMER NO. 24041
Simpson & Simpson, PLLC
5555 Main Street
Williamsville, NY 14221-5406
Telephone No. 716-626-1564

CPM
Dated: September 26, 2006